

**NOTICE OF APPEAL FROM THE EXAMINER TO  
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Docket Number (Optional)

1137.1103101

I hereby certify that this correspondence is being electronically deposited with the "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on January 8, 2007

Signature Lynn Thompson  
Typed or printed name Lynn Thompson

In re Application of  
Scott Fergusson

Application Number  
09916951

Filed  
2001-07-27

For METHODS AND SYSTEMS FOR MONITORING THE EFFICACY OF A  
MARKETING PROJECT

Art Unit  
3623

Examiner  
Linda Kriucunas

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) \$ 500.00

☒ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ 250.00

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 500413; I have enclosed a duplicate copy of this sheet.

☒ Please consider this a one-month petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22).

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 38638

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34. \_\_\_\_\_

Signature  
Brian N. Yulte

Typed or printed name

612.677.9050

Telephone number

January 8, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 37 CFR 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

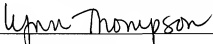
Applicant: Scott Fergusson et al. Examiner: Linda Krisciunas  
Serial No.: 09/916,951 Group Art Unit: 3623  
Filed: July 27, 2001 Docket No.: 1137.1103101  
Confirmation No.: 9341  
For: METHODS AND SYSTEMS FOR MONITORING THE EFFICACY  
OF A MARKETING PROJECT

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Assistant Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**CERTIFICATE OF ELECTRONIC TRANSMISSION**

I hereby certify that this paper is being electronically transmitted to the United States Patent  
and Trademark Office on the date shown below.

  
\_\_\_\_\_  
Lynn Thompson Date January 8, 2007

Applicants submit that the Examiner's rejections contain at least the following clear errors and/or omissions of one or more essential elements needed for a prima facie rejection.

The rejection of claims 25, 26, 28-30, and 36 for failing to comply with the enablement requirement because the specification does not describe "textual matter" is a clear error because these claims do not recite "textual matter." The rejection of claims 1-6, 8-26, and 28-36 as not being enabled is an error because the disclosure provides sufficient information for one of ordinary skill in the art to perform the claimed method steps of providing marketing material that includes "textual matter" and providing a "customized" listing of customers to selected representatives. The standard for enablement is whether experimentation needed to practice the invention is undue or unreasonable (see MPEP 2164.01). Applicants submit that the specification as filed does provide sufficient information to enable one skilled in the art to perform the method step of providing marketing material that includes textual matter, and no undue or unreasonable experimentation would be required. For example, page 4, lines 14-17 and page 15, line 30 through page 16, line 6 of the disclosure describes delivering marketing material in a format that aids the representative in preparing envelopes, post cards, and letters. Page 16, lines 15-18 describes the method step of displaying marketing documents for downloading by the representative. One of ordinary skill in the art, upon reviewing the above specific teachings in the specification, as well as other teachings, would understand that the marketing materials may include "textual matter". Further, claim 1 itself

provides a definition of the "customized" listing of customers as including a listing of the selected customers that the particular representative represents. As discussed on pages 11-12 of the response filed November 8, 2006, it appears the rejection may have been intended to be a lack of written description rejection. MPEP 2164 states that the enablement and written description requirements have separate and distinct criteria. The above rejection of the claims as not being enabled is an error because it cannot readily be argued that "textual matter" or "customized" would not be understood by one skilled in the art. Additionally, as shown above, the specification provides a written description of "textual matter" and "customized" lists.

The rejection of claim 11 as being unclear and indefinite for reciting "and/or" appears to be an error. As discussed on page 14 of the response filed November 8, 2006, "and/or" is merely a shortened way of expressing two specific ideas. MPEP 2173.04 states, "Breadth of a claim is not to be equated with indefiniteness." While the claim may be broader than if it recited only one of "and" or "or", the scope of the claimed subject matter is clear. Additionally, a search of the USPTO database shows the phrase "and/or" is found in the claims of 130,066 issued US patents, suggesting the phrase is acceptable claim language to the US Patent Office.

The Examiner has failed to establish a *prima facie* case of obviousness in the rejection of claims 1-18, 20-30, and 36 as being unpatentable over Melchione et al. The Examiner acknowledges that Melchione et al. fail to teach customized lists, but asserts that it would have been obvious "to modify the lead system of Melchione with a customizable featured one to provide means for segregating customers to the optimal sales person, whether it be by product line or geography" (page 7, 2<sup>nd</sup> paragraph of final action). This assertion supports Applicant's position that Melchione neither teaches nor suggests the claimed method step of providing a customized listing of customers wherein each of the customized listings includes a listing of the selected customers that the particular representative represents. The Examiner asserts that it would have been obvious to modify Melchione to achieve a customized listing based on product line or geography, and not a listing of the selected customers that the particular representative represents. Thus, even if one were to modify Melchione according to the Examiner, one would not arrive at the claimed method steps.

Additionally, the portion of Melchione cited by the Examiner (column 8, lines 61-66) only teaches that a branch managers requests lists of leads for certain sales programs. Melchione also teaches that the personal bankers (representatives) receive a list of leads based on workload or availability (column 9, lines 46-52). The Examiner asserts that customers identified in a query by a

banker would be those that the banker represents since they are in his territory. The Examiner appears to be equating a bank customer's proximity to a bank branch with that person being "represented" by a particular personal banker. Such an interpretation is contrary to the ordinary use of the term "represent". One of ordinary skill in the art would understand that merely because a person lives near a particular bank branch does not mean that the person is represented by the branch and certainly not by any particular banker at that branch. The skilled artisan would understand that a person's bank preference involves many factors, not just location. Additionally, even if a person were a customer of a particular bank branch, he/she is not necessarily represented by any particular personal banker, without some prior established relationship. This is clear from Melchione's teaching that branch managers assign leads to a personal banker based on his/her qualifications or workload and availability. There is no indication that the bank customers in the system of Melchione are represented by any particular personal bankers (representatives). Additionally, Melchione teach the branch managers requesting a listing of customers, and does not appear to teach or suggest a banker (representative) making the query. Thus, Melchione does not appear to teach or suggest a method in which a customized listing of customers is provided to selected representatives, where each customized listing includes a listing of those customers selected based on marketing project parameters and which customers are also represented by that particular representative (banker).

The Examiner asserts that Melchione teaches determining which or how many of the customers that were sent the marketing material by their representatives actually purchased the product. The Examiner appears to be equating the claimed steps with Melchione's teaching that "sales tracking component provides an indication of the amount of revenue generated for the financial institution by each personal banker" (column 41, lines 65-67). The claimed method step involves two separate determinations: (1) which customers were sent marketing material, and (2) which or how many of the customers in (1) actually purchased the product. Melchione's step of determining the amount of revenue generated by each personal banker clearly does not involve these steps. Melchione's method appears to only determine the resulting revenue generated by a banker, without regard to how many customers received marketing material or how many of those customers actually purchased the product. The Examiner's interpretation of Melchione is contrary to the specific teachings of Melchione and is thus clearly improper.

The Examiner's assertion that Melchione provides detailed access to sales transactions for

each banker and one can view sales results for the various campaigns to track the performance and make adjustments in the campaign as needed clearly indicates the Examiner's basis for modifying Melchione is just because one could, which is a clear error. MPEP 2143.01 III states, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Melchione does not suggest the desirability of the asserted modification, and the Examiner has not provided any indication of why one would have been motivated to make such a modification.

The Examiner acknowledges that Melchione fails to teach customized lists, but asserts that the act of querying a database to select customers in your assigned territory that generates a list of leads is deemed equivalent as it performs an identical function in substantially the same manner with substantially the same results. The claimed step requires providing a customized listing of customers including a listing of the selected customers that the particular representative represents. Thus, the listing of customers is customized to a particular representative in that the listing includes those customers actually represented by that particular representative. Melchione teaches a branch manager querying a database to select customers based on suitability for a sales campaign, and then assigning the leads to personal bankers most qualified to handle the leads or based on the workload and availability of the personal bankers (column 9, lines 46-52). The customers on the claimed customized list have two characteristics: (1) they are already represented by the representative, and (2) they meet the marketing project parameters. The customers on the list of Melchione have different characteristics: (1) they apparently live near the branch bank, and (2) they meet the sales campaign criteria.

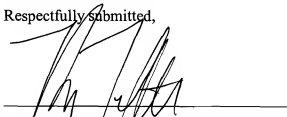
Regarding independent claim 10, the Examiner asserts that the branch workstations of Melchione are deemed equivalent to the claimed "representative" as they perform the identical function in substantially the same manner and produce substantially the same results. Applicants do not understand how a branch workstation can be deemed to "represent" a customer, or how a branch workstation can "elect to provide marketing material...wherein the marketing material is personalized to at least appear to be from the branch workstation." Applicants are particularly unsure how a customer would purchase a product from a branch workstation, as is recited in claim 13. Branch workstations do not perform the identical function to produce substantially the same results as the claimed representative.

The Examiner asserts that Melchione's teaching of tracking the results of the sales promotion

inherently means the representatives were notified of the promotion. Bankers merely being notified of a promotion does not teach the claimed method step of at least some of the representatives reviewing a notice and requesting a customized listing of customers. Melchione appears to teach the marketing material being provided automatically from the micromarketing center. This is not the same as the claimed method step. Dependent claim 26 states the customized listing of selected customers is provided upon initiation by the representative. The Examiner asserts that Melchione teach, in FIG. 1A, the Micromarketing centers as requesting information from the database to obtain the customer information, and asserts that the micromarketing center is the "representative." Independent claim 25, from which claim 26 depends, recites "each representative represents a portion of the customers". The micromarketing center taught by Melchione is not equivalent to the "representatives" because Melchione teaches the micromarketing center provides information to the personal bankers, who then contact customers. Independent claim 36 recites that customers are represented by a single representative. Melchione does not appear to teach customers represented by any particular representative, let alone a single representative.

There does not appear to be any motivation for combining the teachings of Melchione and 17 CFR Part 24. The mere presence of regulations relating to consumer privacy does not provide any motivation, guidance or suggestion for one of ordinary skill in the art to modify the database of Melchione. Melchione does not appear to teach a method in which textual marketing material is checked for compliance, providing the compliant marketing material and a customized listing of selected customers to at least some of the representatives (bankers), and then bankers providing the textual marketing material to at least some of the customers on their customized listing of selected customers. The Examiner has thus failed to establish a *prima facie* case of obviousness.

Respectfully submitted,



Dated: January 8, 2007

Brian N. Tufte, Reg. No. 38,638  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, Minnesota 55403-2420  
Telephone: (612) 359-9348  
Facsimile: (612) 359-9349